Decision for dispute CAC-UDRP-101879

Case number	CAC-UDRP-101879
Time of filing	2018-02-14 09:39:18
Domain names	INTESAISANPAOLO.COM

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	Intesa Sanpaolo S.p.A.

Complainant representative

Organization	Perani Pozzi Associati

Respondent

Organization	Whois Privacy Corp.

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings pending or decided between the same parties and relating to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the registered owner of several trademark registrations containing and or consisting of the terms “INTESA SANPAOLO” in particular:

- International trademark registration n. 920896 “INTESA SANPAOLO”, granted on March 7, 2007, registered for classes 9, 16, 35, 36, 38, 41 and 42; and

- EU trademark registration n. 5301999 “INTESA SANPAOLO”, applied on September 8, 2006 and registered on June 18, 2007 for services in classes 35, 36 and 38.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant claims to be among the top banking groups in the euro zone, with a market capitalisation exceeding 46,4 billion euro, and the undisputed leader in Italy, in all business areas (retail, corporate and wealth management).

It further contends its mark “INTESA SANPAOLO” to be distinctive and well-known worldwide.

The Respondent registered the disputed domain name on December 19, 2017. The disputed domain name resolves to an inactive page.

On January 9, 2018 the Complainant’s attorneys sent a cease and desist letter to the Respondent, asking for the voluntary transfer of the disputed domain name to the Complainant. The Respondent did not reply to this letter.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

1.
The Panel finds that the disputed domain name is confusingly similar to the Complainant’s trademarks.

Many Panels have found that a domain name is confusingly similar to a complainant’s trademark where it incorporates the complainant’s trademark in its entirety. This is the case in the case at issue where the Complainant’s registered trademark “INTESA SANPAOLO” is fully included in the disputed domain name.

Furthermore, it is the view of this Panel that the addition of a single letter “I” between the two terms constituting the trademark “INTESA SANPAOLO” do not add distinctive matter so as to distinguish the disputed domain name from Complainant’s trademark.

2.
In the absence of any response, or any other information from the Respondent indicating the contrary, the Panel further holds that the Complainant successfully presented its prima facie case and that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

In particular, the Respondent is not affiliated with nor authorized by the Complainant in any way, and it is not related in any way to the Complainant’s business. In addition, the Respondent is not commonly known by the disputed domain name. Finally, the website to which the disputed domain name resolves is inactive. This can neither be considered as bona fide offering of goods or services nor a legitimate non-commercial or fair use of the disputed domain name, without intent for

commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. In fact, there is no use at all.

3.
Finally, the Panel finds that the disputed domain name has also been registered and is being used in bad faith.

First it is to be noted that the non-use of a disputed domain name does not prevent a finding of bad faith under the doctrine of passive holding.

It is the view of this Panel that the Respondent has intentionally registered the disputed domain name, which fully includes the Complainant's trademark "INTESA SANPAOLO". In addition, the Panel notes that Complainant's trademark "INTESA SANPAOLO" is deemed well-known. Therefore, it is the view of this Panel that the Respondent knew or should have known that the disputed domain name is almost identical to the Complainant's trademark when it registered the disputed domain name. Registration of a domain name in awareness of a reputed trademark and in the absence of rights or legitimate interests amounts to registration in bad faith.

Considering the high similarity between the trademark "INTESA SANPAOLO" and the disputed domain name, which suggests the Respondent's awareness of the trademark, the Panel finds that the Respondent registered and is using the disputed domain name for bad faith purposes. Relevant factors are (i) the high degree of distinctiveness and the worldwide reputation of the Complainant's mark, (ii) the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good faith use, (iii) the failure of the Respondent to reply to the warning letter and (iv) the implausibility of any good faith use to which the disputed domain name may be put.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **INTESAISANPAOLO.COM**: Transferred

PANELLISTS

Name	**Dr. Tobias Malte Müller**

DATE OF PANEL DECISION 2018-03-29

Publish the Decision